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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,040	02/05/2001	Gary A. Sigel	A148 1330	8701

7590

05/05/2004

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EXAMINER


FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/777,040	Applicant(s) SIGEL ET AL. 	
	Examiner Lawrence D Ferguson	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 38-45 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 38-45 and 55-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/26/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed February 19, 2004.
Examiner regrets the untimely reopening of the case and withdraws the previous rejections to further prosecute the claimed invention. Claims 1-22, 38-45 and 55-60 are pending in this case.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 1-22, 38-45 and 55-60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1-3, 9-12, 38 and 55 the term, "thermoset" is not supported by the specification.

Claim Rejections – 35 USC § 102(b)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller Jr. et al. (U.S. 5,712,222).

Miller Jr. discloses a surface covering comprising a base (substrate) having on the upper surface a printed design and particles and a cured clear or translucent wear layer overlying the base, whereby the wear layer (top coat) surface in the areas containing particles and areas not containing particles will be of different gloss characteristics (column 2, lines 24-52). Miller Jr. further discloses the wear layer is UV curable (column 3, line 16 and 41) where color can be applied to the substrate to provide designs along with a UV curable undercoat (column 3, lines 40-52). The reference discloses the glosses are controllable (column 3, lines 60-64). Although Miller Jr. does not explicitly teach the wear layer is thermoset, Applicant lacks support for this feature of the claimed invention.

Claim Rejections – 35 USC § 103(a)

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1, 3-4, 7-13, 15-22, 38-42, 44-45 and 55-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller Jr. et al. (U.S. 5,712,222) in view of Richard (U.S. 5,091,211).

Miller Jr. is relied upon for claim 1 as above. Miller Jr. does not disclose the wear layer having photosensitizers or flattening agents. Richard teaches a surface covering comprising a coated substrate, where the wear layer is bonded to the substrate and the radiation cured coating comprises a photoinitiator (column 3, lines 46-68). Richard further teaches the coating also includes pigments and flatting agents (column 5, lines 44-52). In instant claims 16 and 19, the phrases, "wherein the second polymerization condition takes places after the first polymerization condition" and "is polymerized in register with the photoinitiator in the selected regions by UV irradiation" introduces process limitations to the product claims. In claim 20, the phrase, "is subsequently polymerized by electron beam irradiation" and in claim 22, the phrase, "wherein the UV curable composition is subsequently further polymerized by electron beam irradiation or UV irradiation under conditions different than the UV irradiation in claim 21 and/or by longer exposure times" also introduce process limitations to the product claims. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Miller Jr. and Richard are analogous art because they both are from the field of surface coverings. It would have been obvious to one of ordinary skill in the art to include photosensitizers and flattening agents in the wear layer of Miller Jr. because Richard teaches these materials help improve the bond of the wear layer to the base (column 1, line 60 through column 2, line 2).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Colyer (U.S. 4,456,643) teaches a floor covering having differential surface gloss comprising a substrate and a top layer (column 1, lines 34-50) and column 2, lines 25-44). Colyer does not teach the top coat being formed from a radiation curable composition.

Response to Arguments


9. Remarks to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Schmidle et al. (U.S. 4,491,616) in view of Sherman et al (U.S. 5,985,416) are moot based on grounds of new rejection. Additionally, remarks to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Schmidle et al. (U.S. 4,491,616) in view of Sherman et al (U.S. 5,985,416) further in view of Sigel et al. (U.S. 6,333,076) are moot based on grounds of new rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

